IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

SOPHOS INC., Plaintiff, vs. RPOST HOLDINGS, INC., RPOST COMMUNICATIONS LIMITED, Defendants.	Civil Action No. 13-cv-12856-DJC JURY TRIAL DEMANDED
RPOST HOLDINGS, INC. and RPOST COMMUNICATIONS LIMITED, Plaintiffs, v. SOPHOS INC., Defendant.	Civil Action No. 14-cv-13628-DJC JURY TRIAL DEMANDED

DEFENDANT SOPHOS INC.'S PRELIMINARY NONINFRINGEMENT AND INVALIDITY CONTENTIONS

Pursuant to the Court's Scheduling Order and Discovery Plan (Dkt. Nos. 85/64) and the Local Rules of the United States District Court for the District of Massachusetts, Plaintiff Sophos Inc. ("Sophos") hereby provides its Preliminary Noninfringement and Invalidity Contentions to RPost Holdings, Inc. and RPost Communications Ltd. (collectively "RPost") with respect to the Asserted Claims identified by RPost in its Preliminary Infringement Disclosure ("Infringement Disclosure") of April 28, 2015, which are as follows:

- Claims 1-5, 7-10, 12-19, 21-24, 26-27, 30 of U.S. Patent No. 8,504,628 ("the '628 patent");[1]
- Claims 1, 4-5, 7, and 10-16 of U.S. Patent No. 8,209,389 ("the '389 patent");
- Claims 1, 2, 3, 6, and 7 of U.S. Patent No. 8,468,199 ("the '199 patent"); and
- Claims 1-2 of U.S. Patent No. 8,224,913 ("the '913 patent") (collectively "the Asserted Claims" or "Asserted Patents").

As disclosed herein, Sophos does not infringe the Asserted Claims and Sophos contends that the Asserted Claims are invalid at least under 35 U.S.C. §§ 101, 102, 103, and/or 112.

I. RESERVATION OF RIGHTS

The following contentions are subject to amendment pursuant to the Court's Scheduling Order and Discovery Plan (Dkt. Nos. 85/64), the Local Rules of the District of Massachusetts, and Rule 26(e) of the Federal Rules of Civil Procedure in light of, for example, ongoing investigation and discovery regarding the claims and defenses asserted by Sophos, the Court's claim construction, and expert discovery. Sophos reserves the right to amend the disclosures and document production provided herein should RPost amend its Infringement Disclosure or provide any information that it failed to provide in its Infringement Disclosure. Further, because discovery is not yet complete and because Sophos's search for relevant documents and prior art is ongoing, Sophos reserves the right to amend the information provided herein, including

[1] RPost has asserted claim 11 of the '628 patent in RPost's Infringement Disclosure (at 2), but RPost has charted the language of claim 12 instead of claim 11 in Exhibit A to RPost's Infringement Disclosure (at 33). In correspondence to counsel for RPost dated May, 21, 2015, counsel for Sophos identified this inconsistency—among other deficiencies with RPost's infringement contentions—and requested that RPost correct this deficiency by May 29, 2015 or provide a time no later than June 3, 2015 to meet and confer. Sophos has received neither amended contentions nor a response to its request to meet and confer. Sophos further notes that RPost's Infringement Disclosure (at 2) purports to assert claim 25 of the '628 patent, but claim 25 is not charted in Exhibit A to RPost's Infringement Disclosure.

identifying, charting, and relying on additional documents, source code, and prior art. Sophos reserves the right to amend any contentions herein depending on any findings as to the priority or invention date of the Asserted Claims or positions RPost or its experts may take concerning claim construction, infringement, or invalidity issues.

As Sophos has informed RPost, RPost's Infringement Disclosure is deficient, and it is unclear what products or combinations of products RPost alleges infringe the Asserted Claims. Furthermore, Sophos does not know whether RPost will contend that certain limitations of the Asserted Claims are not disclosed in the prior art identified by Sophos. Sophos therefore reserves the right to identify other documents that would demonstrate the noninfringement of Sophos's accused products or render invalid the allegedly missing limitation(s) of the cited prior art reference.

To the extent the following contentions reflect constructions of claim limitations consistent with or implicit in RPost's Infringement Disclosure, no inference is intended nor should any be drawn that Sophos agrees with RPost's interpretation of any claim limitation, and Sophos expressly reserves the right to contest RPost's interpretation of such claim limitations.

Sophos further intends to rely on testimony, source code and additional documentation to demonstrate the noninfringement of Sophos's accused products. Additionally, Sophos intends to rely on inventor admissions concerning the scope of the prior art relevant to the Asserted Patents found in the prosecution history of each Asserted Patent (or related patents or applications), the testimony of the named inventor on the Asserted Patents and any other relevant evidence.

Sophos cites particular teachings and disclosures of the prior art as applied to features of the Asserted Claims. The cited portions are only examples, and Sophos reserves the right to rely on other portions of the prior art (including any information incorporated by reference) and on other publications, expert testimony, and other evidence as aids in understanding the cited portions and as additional evidence that the prior art discloses a claim limitation. Where Sophos cites to a particular figure in prior art, the citation should be understood to encompass the caption and description of the figure and any text relating to or discussing the figure. Conversely, where Sophos cites to particular text referring to a figure, the citation includes the figure as well.

The prior art disclosed in the claim charts attached as Exhibits A to D may disclose the limitations of the Asserted Claims explicitly or inherently, and they may be relied upon to show the state of the art at the relevant time. The suggested obviousness combinations are provided in the alternative to Sophos's anticipation contentions and are not to be construed to suggest that any item of prior art included in the combinations is not by itself anticipatory.

Sophos reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event that Sophos obtains evidence that the named inventor did not invent (either alone or in conjunction with others) the subject matter claimed in the Asserted Patents. If Sophos obtains such evidence, it will provide the name of the person(s) from whom, and the circumstances under which, the invention or any part of it was derived.

Sophos also expressly reserves the right to challenge any of the claim terms herein under 35 U.S.C. § 101, 35 U.S.C. § 102, 35 U.S.C. § 103 and 35 U.S.C. § 112, including by arguing that they are indefinite, not supported by the written description, not enabled, or fail to disclose the best mode contemplated by the inventor(s). Nothing stated herein shall be construed as a waiver of any argument available under 35 U.S.C. §§ 101, 102, 103 and/or 112. Sophos further reserves the right to supplement its Local Rule 16.6, Appendix E ¶ (A)(2) document production, should Sophos later find additional responsive documents.

II. NONINFRINGEMENT CONTENTIONS

Pursuant to the Court's Scheduling Order and Discovery Plan and Local Rule 16.6, Appendix E ¶ (A)(2), Sophos asserts that it does not infringe, directly or indirectly, literally or under the doctrine of equivalents, the Asserted Claims of the Asserted Patents.

Sophos provides claim charts for the Asserted Patents, which are attached as Exhibits E to H to these contentions. The claim charts identify for each Asserted Claim those limitations that are not directly or indirectly infringed by Sophos. Because Sophos does not directly infringe any Asserted Claim, Sophos has not induced or contributed to the infringement of the claims.

III. INVALIDITY CONTENTIONS

Pursuant to the Court's Scheduling Order and Discovery Plan and Local Rule 16.6, Appendix E ¶ (A)(2), Sophos contends that the Asserted Claims of the Asserted Patents are invalid at least under 35 U.S.C. §§ 101, 102, 103, and/or 112.

Sophos provides invalidity contention charts for the Asserted Patents, which are attached as Exhibits A to D to these contentions. The invalidity charts identify for each Asserted Claim where in each item of prior art each limitation of each Asserted Claim is found. Sophos submits these invalidity contentions without waiving its position that RPost's Infringement Disclosure is deficient and does not comply with the Local Rules.

Sophos's production pursuant to the Court's Scheduling Order and Discovery Plan and Local Rule 16.6, Appendix E ¶ (A)(2) and future supplemental productions may contain additional items of prior art that render one or more of the Asserted Claims invalid. For example, Sophos expects to receive documents from third parties (either through informal requests or under subpoena) who are believed to have knowledge, documentation, or corroborating evidence concerning the prior art identified below and additional prior art.

In addition, Sophos intends to rely upon all prior art references disclosed, listed and/or asserted as prior art by any entity during the course of other litigation or reexamination involving any of the Asserted Patents and any other related patents. Sophos incorporates by reference all invalidity contentions served on RPost by any defendant in other litigation. Sophos intends to rely upon any additional prior art references discussed or disclosed in any expert report on the invalidity of the Asserted Patents, in this litigation or any other litigation or reexamination involving the Asserted Patents and any related patents. Sophos also intends to rely on references identified in the file histories of the Asserted Patents and related patents or applications, as well as any reexaminations of the Asserted Patents.

A. Invalidity of the Asserted Claims Under 35 U.S.C. § 101.

Sophos contends that the Asserted Claims are invalid under 35 U.S.C. § 101 for failure to meet the patent-eligible requirements of that section. Section 101 of the Patent Act states: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title." Sophos identifies below the Asserted Claims that fail to satisfy the requirements of 35 U.S.C. § 101.

Section 101 precludes the patenting of mental processes and abstract ideas. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012) (quotation omitted). There, the Supreme Court set forth a framework for distinguishing patents that claim laws of nature, natural phenomena and abstract ideas from those that claim patent-eligible applications of those concepts. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354-2357 (2014). First, a Court must determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, the Court must then ask, "[w]hat else is there in the claims before us?" To answer that question, courts should consider the elements of each claim both individually and "as an ordered combination" to determine whether the additional elements "transform the nature of the claim" into a patent-eligible application. Step two of this analysis has been described as a search for an "inventive concept"—an element or combination of elements that is "sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself." *Id.*

Based on Sophos's present understanding of the Asserted Claims, at least the following claims (and those that depend from them) fail to satisfy the requirements of 35 U.S.C. § 101:

- '628 patent: claims 1, 14, and 30;
- '389 patent: claims 1, 4, 5, 14-16;
- '199 patent: claims 1, 2, 3, 6, 7; and
- '913 patent: claims 1, 2.

B. Invalidity of the Asserted Claims Under 35 U.S.C. §§ 102 and 103.

Sophos contends the Asserted Claims are invalid under 35 U.S.C. §§ 102 or 103.

The following patents, publications, products and/or systems are anticipatory prior art for one or more Asserted Claims under at least 35 U.S.C. § 102, and/or render obvious one or more of the Asserted Claims under 35 U.S.C. § 103, alone or in combination with other references, as set forth in more detail in Exhibits A to D:

'199 Patent

- Certified Exchange of Electronic Mail ("CEEM"), by Bassam Al-Hammadi et al.;
- Certified Electronic Mail ("CEM"), by Alireza Bahreman et al.;
- International Patent Application Publication No. WO 97/08869 in the name of Feldbau et al. ("Feldbau");
- Sendmail, Second Edition ("Sendmail") by Bryan Costales et al.;

- Trend InterScan VirusWall, version 3 (“VirusWall”);
- U.S. Patent No. 6,618,747 (“Flynn”);
- Requests for Comment 1891-1894 (“RFCs 1891-1894”);
- Integralis Ltd.’s MIMEsweeper (“MIMEsweeper”);
- MIMEsweeper Administrator Guide (“MIMEsweeper Admin. Guide”);
- Sophos’s Sweep-InterCheck (“Sweep-IC”)(as described by SWEEP for Windows NT User Manual, August 1996 (“Sweep User Manual”); and
- “Privacy-Enhanced Mail (PEM),” by Michael A. Gurski (“PEM”).

’389 Patent

- Certified Exchange of Electronic Mail (“CEEM”), by Bassam Al-Hammadi et al.;
- Certified Electronic Mail (“CEM”), by Alireza Bahreman et al.;
- International Patent Application Publication No. WO 97/08869 in the name of Feldbau et al. (“Feldbau”);
- Sendmail, Second Edition (“Sendmail”) by Bryan Costales et al.;
- U.S. Patent No. 6,618,747 (“Flynn”);
- Requests for Comment 1891-1894 (“RFCs 1891-1894”);
- Integralis Ltd.’s MIMEsweeper (“MIMEsweeper”);
- MIMEsweeper Administrator Guide (“MIMEsweeper Admin. Guide”);
- Sophos’s Sweep-InterCheck (“Sweep-IC”)(as described by SWEEP for Windows NT User Manual, August 1996 (“Sweep User Manual”); and
- “Privacy-Enhanced Mail (PEM),” by Michael A. Gurski (“PEM”).

’913 Patent

- Certified Exchange of Electronic Mail (“CEEM”), by Bassam Al-Hammadi et al.;

- Certified Electronic Mail (“CEM”), by Alireza Bahreman et al.;
- Gauntlet Firewall for UNIX – Administrator’s Guide Version 4.2 (1996) (“Gauntlet”);
- Sendmail, Second Edition (“Sendmail”) by Bryan Costales et al.;
- John Markoff, Sharing Software, IBM to Release Mail Program Blueprint (“Postfix”);
- Cameron Laird, Venema Aims to Make Network Software Safe (“Postfix 2”);
- Postfix Source Code (Dec. 11, 1998); and
- postfix-19990906-pl09.tar.gz.;
- Integralis Ltd.’s MIMEsweeper (“MIMEsweeper”);
- MIMEsweeper Administrator Guide (“MIMEsweeper Admin. Guide”); and
- Sophos’s Sweep-InterCheck (“Sweep-IC”)(as described by SWEEP for Windows NT User Manual, August 1996 (“Sweep User Manual”).

’628 Patent

- Integralis Ltd.’s MIMEsweeper (“MIMEsweeper”);
- MIMEsweeper Administrator Guide (“MIMEsweeper Admin. Guide”);
- Sophos’s Sweep-InterCheck (“Sweep-IC”)(as described by SWEEP for Windows NT User Manual, August 1996 (“Sweep User Manual”);
- U.S. Patent No. 4,037,956 to McKeen, Jr. (“McKeen”);
- U.S. Pat No. 6,393,568 to Ranger et al. (“Ranger ’568”);
- U.S. Pat. No. 7,265,853 to Kara et al. (“Kara ’853”);
- Zhou, J., and Gollmann, D., “Certified Electronic Mail” (“Zhou CEM Article”);

- Bahreman, A., and Tygar, J.D., “Certified Electronic Mail” (“Bahreman CEM Article”); and
- Kent, S., “Internet Privacy Enhanced Mail” (“Kent PEM”).

Sophos specifies in Exhibits A to D whether each item of prior art identified above anticipates or renders obvious (either alone or in combination with other references) the Asserted Claims, and explains its invalidity contentions with respect to each of the Asserted Patents in more detail below.

1. The ’199 Patent

RPost does not contend in its Infringement Disclosure that the priority date for each of the Asserted Claims of the ’199 patent is any earlier than the provisional application filing date of July 28, 1999. Without waiving its right to contend that the Asserted Claims of the ’199 patent are not entitled to the benefit of the provisional application filing date, Sophos contends that the Asserted Claims of the ’199 patent are anticipated and/or rendered obvious by at least the items of prior art identified in Exhibits A1 to A9. The prior art cited in Exhibits A1 to A9 is illustrative and not exhaustive and is subject to the reservations of rights set forth in Section I above.

To the extent any Asserted Claim is not anticipated by the prior art identified in Exhibits A1 to A9, the Asserted Claims are obvious because they merely combine familiar elements according to known methods to achieve predictable results, or they choose between clear alternatives known to those of ordinary skill in the art. Furthermore, the obviousness combinations identified in Exhibits A1 to A9 are not exclusive, and Sophos reserves the right to supplement these combinations using any items of prior art that may become known or their relevance become known to Sophos during the course of discovery.

One or more combinations of the items of prior art identified in Exhibits A1 to A9 would have been obvious because these items of prior art would have been combined using known methods to yield predictable results, or known techniques in the same way, or a simple substitution of a known, equivalent element for another to obtain predictable results, or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art identified in Exhibits A1 to A9, because there were only a finite number of predictable solutions or because known work in one field of endeavor prompted variations based on predictable design incentives or market forces either in the same field or a different one. In addition, the combination of prior art identified in Exhibits A1 to A9 would have been obvious because the combination represents the known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine the items of prior art identified in Exhibits A1 to A9 includes the interrelated teachings of multiple items of prior art; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art. For example, the items of prior art are generally directed to the same problems:

- "wherein the copy of the first information is stored in a memory in communication with the server." *See, e.g.*, the evidence and information cited for claim 2 of the '199 patent in Exhibits A1 to A9.

- "wherein transmitting, before any authentication of the message, includes transmitting a copy of the message and the first information to the sender from the server." *See, e.g.*, the evidence and information cited for claim 3 of the '199 patent in Exhibits A1 to A9.
- "wherein the first information is an authenticatible information which also includes a plurality of digits in a unique sequence." *See, e.g.*, the evidence and information cited for claim 6 of the '199 patent in Exhibits A1 to A9.
- "wherein transmitting a copy of the message and the first information to the sender includes also sending a time of transmission of the message to the recipient to the sender." *See, e.g.*, the evidence and information cited for claim 7 of the '199 patent in Exhibits A1 to A9.

Sophos asserts that abundant motivation to combine would exist for any items of prior art that discuss computer and/or network security, such as, and without limitation, systems and methods for categorizing the content of network traffic and taking actions based on such categorization. A person of ordinary skill in the art at the relevant time would have understood that systems and methods for categorizing the content of network traffic and taking actions based on such categorization were in widespread use and that such systems could have been readily combined with other systems and methods that use categorization techniques. For these reasons, there would have been abundant motivation to combine the prior art as described above and in Exhibits A1 to D9.

2. The '389 Patent

RPost does not contend in its Infringement Disclosure that the priority date for each of the Asserted Claims of the '389 patent is any earlier than the provisional application filing date of July 28, 1999. Without waiving its right to contend that the Asserted Claims of the '389 patent are not entitled to the benefit of the provisional application filing date, Sophos contends that the Asserted Claims of the '389 patent are anticipated and/or rendered obvious by at least the items of prior art identified in Exhibits B1 to B9. The prior art cited in Exhibits B1 to B9 is illustrative and not exhaustive and is subject to the reservations of rights set forth in Section I above.

To the extent any Asserted Claim is not anticipated by the prior art identified in Exhibits B1 to B9, the Asserted Claims are obvious because they merely combine familiar elements according to known methods to achieve predictable results, or they choose between clear alternatives known to those of ordinary skill in the art. Furthermore, the obviousness combinations identified in Exhibits B1 to B9 are not exclusive, and Sophos reserves the right to supplement these combinations using any items of prior art that may become known or their relevance become known to Sophos during the course of discovery.

One or more combinations of the items of prior art identified in Exhibits B1 to B9 would have been obvious because these items of prior art would have been combined using known methods to yield predictable results, or known techniques in the same way, or a simple substitution of a known, equivalent element for another to obtain predictable results, or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art identified in Exhibits B1 to B9, because there were only a finite number of predictable solutions or because known work in one field of endeavor prompted variations based on predictable design incentives or market forces either in the same field or a different one. In addition, the combination of prior art identified in Exhibits B1 to B9 would have been obvious because the combination represents the known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine the items of prior art identified in Exhibits B1 to B9 includes the interrelated teachings of multiple items of prior art; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art. For example, the items of prior art are generally directed to the same problems:

- “Wherein the first information is an authenticatible information which also includes a plurality of digits in a unique sequence.” *See, e.g.*, the evidence and information cited for claim 4 of the ’389 patent in Exhibits B1 to B9.
- “wherein transmitting a copy of the message and the first information to the sender includes also sending a time of transmission of the message to the recipient to the sender.” *See, e.g.*, the evidence and information cited for claim 5 of the ’389 patent in Exhibits B1 to B9.
- “Storing a representation of the message and the first information received by the server from the recipient in a memory, before any authentication of the message.” *See, e.g.*, the evidence and information cited for claim 14 of the ’389 patent in Exhibits B1 to B9.
- “Transmitting the representation of the message and the first information received by the server from the recipient to the sender from the server.” *See, e.g.*, the evidence and information cited for claim 15 of the ’389 patent in Exhibits B1 to B9.
- “An authenticatable information … is sent by the server to the sender with the representation of the message before the message is authenticated by the server.” *See, e.g.*, the evidence and information cited for claim 16 of the ’389 patent in Exhibits B1 to B9.

Sophos asserts that abundant motivation to combine would exist for any items of prior art that discuss computer and/or network security, such as, and without limitation, systems and methods for categorizing the content of network traffic and taking actions based on such categorization. A person of ordinary skill in the art at the relevant time would have understood that systems and methods for categorizing the content of network traffic and taking actions based on such categorization were in widespread use and that such systems could have been readily combined with other systems and methods that use categorization techniques. For these reasons, there would have been abundant motivation to combine the prior art as described above and in Exhibits B1 to B9.

3. The ’913 Patent

RPost does not contend in its Infringement Disclosure that the priority date for each of the Asserted Claims of the ’913 patent is any earlier than the provisional application filing date of July 28, 1999. Without waiving its right to contend that the Asserted Claims of the ’913 patent are not entitled to the benefit of the provisional application filing date, Sophos contends that the Asserted Claims of the ’913 patent are anticipated and/or rendered obvious by at least the items of prior art identified in Exhibits C1 to C6. The prior art cited in Exhibits C1 to C6 is illustrative and not exhaustive and is subject to the reservations of rights set forth in Section I above.

To the extent any Asserted Claim is not anticipated by the prior art identified in Exhibits C1 to C6, the Asserted Claims are obvious because they merely combine familiar elements according to known methods to achieve predictable results, or they choose between clear alternatives known to those of ordinary skill in the art. Furthermore, the obviousness combinations identified in Exhibits C1 to C6 are not exclusive, and Sophos reserves the right to supplement these combinations using any items of prior art that may become known or their relevance become known to Sophos during the course of discovery.

One or more combinations of the items of prior art identified in Exhibits C1 to C6 would have been obvious because these items of prior art would have been combined using known methods to yield predictable results, or known techniques in the same way, or a simple substitution of a known, equivalent element for another to obtain predictable results, or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art identified in Exhibits C1 to C6, because there were only a finite number of predictable solutions or because known work in one field of endeavor prompted variations based on predictable design incentives or market forces either in the same field or a different one. In addition, the combination of prior art identified in Exhibits C1 to C6 would have been obvious because the combination represents the known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine the items of prior art identified in Exhibits C1 to C6 includes the interrelated teachings of multiple items of prior art; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art. For example, the items of prior art are generally directed to the same problems:

- "Recording at the server some portion of the selected one of the SMTP and ESMTP protocol dialog between the server and the recipient through the server." *See, e.g.*, the evidence and information cited for claim 1 of the '913 patent in Exhibits C1 to C6.
- "Including those portions of the selected one of the SMTP and ESMTP protocol dialog between the server and the recipient in which the receiving Mail Transport Agent accepts or declines delivery of the transmitted message." *See, e.g.*, the evidence and information cited for claim 1 of the '913 patent in Exhibits C1 to C6.
- "Returning to the sender an e-mail message including a copy of the recorded dialog as proof of the successful delivery or failure to deliver the message to the recipient's mail server." *See, e.g.*, the evidence and information cited for claim 1 of the '913 patent in Exhibits C1 to C6.

Sophos asserts that abundant motivation to combine would exist for any items of prior art that discuss computer and/or network security, such as, and without limitation, systems and methods for categorizing the content of network traffic and taking actions based on such categorization. A person of ordinary skill in the art at the relevant time would have understood that systems and methods for categorizing the content of network traffic and taking actions based on such categorization were in widespread use and that such systems could have been readily combined with other systems and methods that use categorization techniques. For these reasons, there would have been abundant motivation to combine the prior art as described above and in Exhibits C1 to C6.

4. The '628 Patent.

RPost does not contend in its Infringement Disclosure that the priority date for each of the Asserted Claims of the '628 patent is any earlier than the provisional application filing date of July 28, 1999. Without waiving its right to contend that the Asserted Claims of the '628 patent are not entitled to the benefit of the provisional application filing date, Sophos contends that the Asserted Claims of the ’628 patent are anticipated and/or rendered obvious by at least the items of prior art identified in Exhibits D1 to D7. The prior art cited in Exhibits D1 to D7 is illustrative and not exhaustive and is subject to the reservations of rights set forth in Section I above.

To the extent any Asserted Claim is not anticipated by the prior art identified in Exhibits D1 to D7, the Asserted Claims are obvious because they merely combine familiar elements according to known methods to achieve predictable results, or they choose between clear alternatives known to those of ordinary skill in the art. Furthermore, the obviousness combinations identified in Exhibits D1 to D7 are not exclusive, and Sophos reserves the right to supplement these combinations using any items of prior art that may become known or their relevance become known to Sophos during the course of discovery.

One or more combinations of the items of prior art identified in Exhibits D1 to D7 would have been obvious because these items of prior art would have been combined using known methods to yield predictable results, or known techniques in the same way, or a simple substitution of a known, equivalent element for another to obtain predictable results, or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art identified in Exhibits D1 to D7, because there were only a finite number of predictable solutions or because known work in one field of endeavor prompted variations based on predictable design incentives or market forces either in the same field or a different one. In addition, the combination of prior art identified in Exhibits D1 to D7 would have been obvious because the combination represents the known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine the items of prior art identified in Exhibits D1 to D7 includes the interrelated teachings of multiple items of prior art; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art. For example, the items of prior art are generally directed to the same problems:

- "wherein processing the message by the server in accordance with the particular indication includes transmitting the message to a second server remote from the recipient to register the message, the registration of the message serving as proof of at least one parameter selected from a list of parameters consisting of proof of receipt, proof of delivery, proof of time of sending, proof of time of receipt, proof of content, and proof of reading by the recipient." *See, e.g.*, the evidence and information cited for claim 3 of the '628 patent in Exhibits D1 to D7;
- "wherein processing the message by the server in accordance with the particular indication includes transmitting the message to a second server remote from the recipient to process the message in a special manner to provide for at least one parameter selected from a list of parameters consisting of a record of content, record of receipt, record of delivery, an indication that the message has been read by the recipient, a record of privacy, an indication of tampering with the message, an indication that the message has been encrypted, a process to encrypt the message to transmit in a more private manner, and preparing for recipient electronic signature on the email message body, attachments, or recording of reply content." *See, e.g.*, the evidence and information cited for claim 4 of the '628 patent in Exhibits D1 to D7;

- "wherein processing the message in a special manner includes recording the content of a reply to the message transmitted by a recipient of the message." *See, e.g.*, the evidence and information cited for claim 7 of the '628 patent in Exhibits D1 to D7;
- "wherein processing the message by the server in accordance with the particular indication includes processing the message by the server through a special process different than the normal process used by the server, and transmitting the message from the server to the recipient through the first route." *See, e.g.*, the evidence and information cited for claim 8 of the '628 patent in Exhibits D1 to D7;
- "wherein processing the message includes determining whether the particular indication is present in the message." *See, e.g.*, the evidence and information cited for claim 9 of the '628 patent in Exhibits D1 to D7;
- "wherein determining whether the particular indication is present in the message includes filtering the content of the message to determine whether a selected term is present in the message." *See, e.g.*, the evidence and information cited for claim 10 of the '628 patent in Exhibits D1 to D7;
- "wherein the selected term is a non-blank 'cc' field." *See, e.g.*, the evidence and information cited for claim 11 of the '628 patent in Exhibits D1 to D7;
- "wherein the selected term is a flag." *See, e.g.*, the evidence and information cited for claim 12 of the '628 patent in Exhibits D1 to D7;
- "wherein the flag is user selectable." *See, e.g.*, the evidence and information cited for claim 13 of the '628 patent in Exhibits D1 to D7; and,
- "charging the sender a fee for transmitting the message through the second route." *See, e.g.*, the evidence and information cited for claim 16 of the '628 patent in Exhibits D1 to D7.

Sophos asserts that abundant motivation to combine would exist for any items of prior art that discuss computer and/or network security, such as, and without limitation, systems and methods for categorizing the content of network traffic and taking actions based on such categorization. A person of ordinary skill in the art at the relevant time would have understood that systems and methods for categorizing the content of network traffic and taking actions based on such categorization were in widespread use and that such systems could have been readily combined with other systems and methods that use categorization techniques. For these reasons, there would have been abundant motivation to combine the prior art as described above and in Exhibits D1 to D7.

C. Invalidity of the Asserted Claims Under 35 U.S.C. § 112

Sophos contends that the Asserted Claims are invalid under 35 U.S.C. § 112.

1. 35 U.S.C. § 112(1) – Written Description/Enablement.

Sophos contends that the Asserted Claims identified below are invalid under 35 U.S.C. § 112(1) for lack of written description and/or enablement. *See* Exhibit I.

With respect to 35 U.S.C. § 112(1), the patentee is required to, among other things, "describe the invention in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent." *LizardTech, Inc. v. Regents of the U. of Cal.*, 424 F.3d 1336, 1344 (Fed. Cir. 2005) (quoting *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931)). A patent specification must contain a full, clear, concise, and exact description that enables a person of ordinary skill in the art to make and use the invention to the full scope of each patent claim. *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2009); *Automotive Techs. Int'l, Inc. v. BMW of N. Am.*, 501 F.3d 1274, 1282 (Fed. Cir. 2007). Further, the specification "must describe the invention sufficiently to convey to a person of ordinary skill in the art that the patentee had possession of the claimed invention at the time of the application." *LizardTech*, 424 F.3d at 1345. It is the specification, not the knowledge of one skilled in the art, that must supply novel aspects of an invention in order to satisfy § 112(1). *Automotive Techs.*, 501 F.3d at 1283 (quoting *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997)).

Subject to the Sophos's reservation of rights and based on Sophos's present understanding of the Asserted Claims of the Asserted Patents, at least the following Asserted Claims fail to satisfy one or more requirements of 35 U.S.C. § 112(1) because the specification fails to provide an adequate written description and/or enabling disclosure of the identified terms:

- '628 patent: claims 4, 10, 14, 24, and 30;
- '389 patent: claims 1, 4, 7, 10-16;
- '199 patent: claims 1, 2, 3, 6, 7; and
- '913 patent: claim 1.

See Exhibit I.

To the extent an Asserted Claim is invalid for any reason under 35 U.S.C. § 112(1), all claims depending therefrom are invalid for at least the same reasons. Accordingly, each of the asserted dependent claims incorporates by reference all § 112(1) invalidity contentions of the parent claim(s).

2. 35 U.S.C. § 112(2) – Indefiniteness.

Sophos contends that the Asserted Claims identified below are invalid under 35 U.S.C. § 112(2) as indefinite. *See* Exhibit I.

With respect to 35 U.S.C. § 112(2), "[t]he statutory requirement of particularity and distinctness in claims is met only when [the claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise." *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). "Indefiniteness is a matter of claim construction, and the same principles that generally govern claim construction are applicable to determining whether allegedly indefinite claim language is subject to construction." *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1348 (Fed. Cir. 2005). Sophos identifies below the Asserted Claims and any corresponding claim limitations of each Asserted Patent that fail to satisfy the requirements of 35 U.S.C. § 112(2). Moreover, a claim is invalid as indefinite under § 112(2) when it combines a system and a method. *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005).

Subject to Sophos's reservation of rights and based on Sophos's present understanding of the Asserted Claims, at least the following Asserted Claims fail to satisfy the requirements of 35 U.S.C. § 112(2) due to the identified terms being indefinite.

- '628 patent: claims 1, 2, 3, 5, 7-10, 14, 15, 17-19, 21-24, and 30;
- '389 patent: claims 1, 4, 7, 10-16;
- '199 patent: claims 1, 2, 3, 6, 7; and
- '913 patent: claim 1.

See Exhibit I.

To the extent an Asserted Claim is invalid for any reason under 35 U.S.C. § 112(2), all claims depending therefrom are invalid for at least the same reasons. Accordingly, each of the asserted dependent claims incorporates by reference all § 112(2) invalidity contentions of the parent claim(s).

3. 35 U.S.C. § 112(6) – Means-Plus-Function Indefiniteness.

When the claim language invokes § 112(6), the claim term is invalid as indefinite if no structure in the specification corresponds to the means-plus-function limitation in the claims. *Robert Bosch, LLC v. Snap-On Inc.*, 769 F.3d 1094, 1097-98 (Fed. Cir. Oct. 14, 2014). With respect to computer-implemented means or step plus function claims, the specification must disclose a sufficient, corresponding algorithm as structure for each function. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1313 (Fed. Cir. 2012). Subject to the Sophos's reservation of rights and based on Sophos's present understanding of the Asserted Claims of the Asserted Patents, Sophos identifies the following limitation with respect to 35 U.S.C. § 112(6) that are indefinite:

- '628 patent: claims 1, 2, 3, 5, 7-10, 14, 15, 17-18, and 22-24.

See Exhibit I.

IV. DOCUMENT PRODUCTION PURSUANT TO LOCAL RULE 16.6 AND SCHEDULING ORDER AND DISCOVERY PLAN

Pursuant to the Court's Scheduling Order and Discovery Plan and Local Rule 16.6, Appendix E ¶ (A)(2), Sophos is concurrently serving today documents sufficient to show the operation of the accused products and/or methods that RPost has identified in its Infringement Disclosure. In addition, Sophos is concurrently serving today documents relevant to its invalidity defenses. Sophos reserves the right to supplement this document production, should Sophos later find additional responsive documents.

Dated: June 9, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on this 9th day of June 2015, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3). Any other counsel of record will be served by a facsimile transmission and/or first class mail.

/s/ Nicholas G. Papastavros
Nicholas G. Papastavros